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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,984	09/25/2006	Gerhard Meixner	3825	3404

7590 08/14/2008

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EXAMINER	
LOPEZ, MICHELLE	

ART UNIT	PAPER NUMBER
3721	

MAIL DATE	DELIVERY MODE
08/14/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/593,984	MEIXNER ET AL.	
	Examiner	Art Unit	
	Michelle Lopez	3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 September 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *25 September 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *9/25/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 9/25/06 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-6, 9-12, and 14-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Stirm et al. 7,331,407. Stirm discloses an electric power tool having a drive unit (via motor shaft

as best shown in figs. 3, 5-7, and 12) contained in a housing (fig. 1), an impact mechanism and a handle 6 (see fig. 1); a cam (533,633,833,1033,1133,1233,1332); the impact mechanism has moving parts, wherein at least two of the moving parts are able to move inside a guide cylinder (530,630,730,930, etc.) that is stationary in relation to the moving parts and the cam (claim 1). A piston and a striker are provided as the moving parts (claim 2). The piston is connected to the drive unit by means of a drive element as a crank rod (claims 3-4). The piston and the drive element are connected to each other by a pin 36 as best shown in fig. 1 (claim 5), wherein a pin axis and a rotation axis of the drive unit are oriented in at an angle to each other (claim 6). The piston and the striker have the same diameter as best shown in the embodiment of fig. 8 (claim 9). A slider crank via 751 is provided to transmit the force between the cam and the drive element, wherein a ball (not shown numerically) is able to move inside the slider crank as shown in fig. 8 (claims 10-11). The embodiments of figs. 6-8 and 10-12 shows a piston and a striker as claimed (claim 15).

With respect to claim 12, the language "it is possible to adjust an angle" is functional and afforded light weight because it is predicated on a future act. Furthermore, the functional language is no supported by sufficient structure to perform the adjustment of said angle.

With respect to claim 14, Stirm's fig. 1 shows wherein the drive unit at the vicinity of 32 is situated centrally in relation to a longitudinal span of the handle 6.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stirm et al. 7,331,407. Stirm discloses an electric power tool having a piston and a drive element connected to each other by a pin, but fails to disclose wherein said piston and drive element are integrally joined to each other. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have integrally connect Stirm's piston and drive element, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art, and it would be for the purpose of reducing manufacturing process and/or costs. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

With respect to claim 8, Stirm fails to disclose wherein said drive element is made from plastic. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided said drive element comprised of plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, and it would be for the benefits of providing a material with the desired rigidity and flexibility for properly transmitting an impact force. *In re Leshin*, 125 USPQ 416.

5. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stirm et al. 7,331,407 in view of Ousback 7,901,981. Stirm discloses an electric power tool having an impact mechanism with a piston and a drive element (crank rod) substantially as claimed, but fails to disclose wherein said drive element has a cranked section which allow adjustment of the angle between a longitudinal axis of the guide cylinder and the a rotation axis of the drive unit. Ousback shows an electric power tool comprising a drive unit 6 with a rotational axis, an impact

mechanism having a guide cylinder 14 with a longitudinal axis and a piston 11 driven within said guide cylinder by a drive element 10, 9 as shown in fig. 1, wherein the drive element has a cranked section provided via the pivotal connection between 10 and 9 for adjusting the angle between the longitudinal axis of the guide cylinder and the rotation axis of the drive unit. It would have been obvious to one having ordinary skill in the art to have provided Stirm's drive element (crank rod) with a cranked section as taught by Ousback in order to change the angle between the rotational axis of the drive element and the longitudinal axis of the guide cylinder.

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stirm et al. 7,331,407 in view of Pyatov 4,828,046. Stirm discloses an electric power tool having a piston substantially as claimed, but fails to disclose wherein said piston is made from a light alloy. Pyatov teaches the concept of a percussion power tool having an impact piston made from a light alloy, i.e. aluminum, for the purpose of provide a piston made from a material which will properly transmit an impact force while enhancing its durability. It would have been obvious to one having ordinary skill in the art to have provided Stirm's piston made from an alloy as taught by Pyatov to provide durability of the piston.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the attached PTO-892 for related art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Lopez whose telephone number is 571-272-4464. The examiner can normally be reached on Monday - Thursday: 8:00 am - 6:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can

be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ML/
Patent Examiner

/Rinaldi I Rada/
Supervisory Patent Examiner, Art Unit 3721